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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,857	06/28/2001	Kenji Kogure	1075.1168	3130
21171	7590	03/03/2006	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			PASS, NATALIE	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 03/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/892,857	Applicant(s) KOGURE, KENJI	
	Examiner Natalie A. Pass	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>28/6/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the application filed 28 June 2001. Claims 1-35 are pending. The IDS filed 28 June 2001 has been entered and considered.

Claim Objections

2. Claims 27-33 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 27-33 recite, "[a]n automated contract engaging program according to claim 26...[or 26, or 27, or 27, or 29, or 29 or 31 respectively]," however claim 26 recites "a computer-readable recording medium." It is unclear whether Applicant is further limiting the medium, or whether applicant seeks protection for the program alone; furthermore, it is unclear how a program further limits a "computer-readable recording medium." These claims do not pass the "Infringement Test" for dependent claims. See MPEP § 608.01 (n).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 12, 14, 26-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention..

- Claims 12, 14 and 29 recite the limitation “the individual remaining customer of the group” in lines 3-4, 4 and 4-5 respectively. There is insufficient antecedent basis for these limitations in the claims.
- Claims 26 and 34 recite the limitation “of the apparatus” in lines 11 and 9, respectively. It is unclear what is meant by this limitation. For the purpose of applying art, Examiner assumes this phrase to be an inadvertent typographical error.
- Claims 27-33 recite “[a]n automated contract engaging program according to claim 26 ... [or 26, or 27, or 27, or 29, or 29 or 31 respectively],” in the preamble. However claim 26 recites “a computer-readable recording medium.” As such, it is unclear whether applicant seeks patent protection for a program or for a computer-readable medium. Please note MPEP section 2106. For the purpose of finding art, Examiner interprets the claims to recite a computer-readable recording medium.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

6. Claims 1-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Silverbrook et al, U.S. Patent Number 6, 959, 298.

(A) As per claim 11, Silverbrook teaches an automated contract engaging method in which a group of customers being a first party and having common personal data except at least name engages a single collective contract or a plurality of individual contracts with a second party on an automated contract engaging apparatus including a display, said method comprising the steps of:

(a) inputting the personal data of a representative customer of the group as first registration data (Silverbrook; Figure 21, column 47, lines 27-28);

(b) inputting at least the name of each of the remaining customers of the group as second registration data (Silverbrook; Figure 51, Figure 81, Figure 82, Figure 84, column 48, line 1); and

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(c) processing and executing the single collective contract or the individual contracts with respect to the plural customers based on said first registration data input in the first-named inputting step (a) and said second registration data input in the second-named inputting step (b) (Silverbrook; Figure 51, Figure 82, Figure 84, column 47, line 61 to column 48, line 2, column 50, lines 50-54).

(B) Claim 23 differs from claim 11 in that claim 11 recites “having common personal data except at least name” in the preamble, while claim 23 does not.

As per claim 23, Silverbrook teaches a an automated contract engaging method in which a group of customers being a first party engages a single collective contract or a plurality of individual contracts with a second party on an automated contract engaging apparatus including a display, said method comprising the steps of:

(a) inputting the personal data of a representative customer of the group as first registration data (Silverbrook; Figure 21, column 47, lines 27-28);

(b) inputting at least the number of the remaining customers of the group as second registration data (Silverbrook; column 30, lines 44-54); and

(c) processing and executing the single collective contract or the individual contracts with respect to the plural customers based on said first registration data input in the first-named inputting step (a) and said second registration data input in the second-named inputting step (b) (Silverbrook; Figure 51, Figure 82, Figure 84, column 47, line 61 to column 48, line 2, column 50, lines 50-54).

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(C) As per claims 12-22, 24-25 Silverbrook teaches a method as analyzed and discussed in claims 11 and 23 above

further comprising the step of (d) inputting the common personal data of the individual remaining customer of the group using part of said first registration data which part is common to the group (Silverbrook; column 29, lines 52-54);

wherein said first registration data is input through a “form” and a “sensing device” (reads on “primary input screen image shown on the display”) in the first-named inputting step (a) (Silverbrook; column 2, lines 45-59); and said second registration data is input through an “interactive form” (reads on “auxiliary input screen image shown on the screen of the display”) in the second-named inputting step (b) (Silverbrook; Figure 1, column 8, lines 3-22);

wherein the part of said first registration data is input as part of the personal data of the individual remaining customer of the group in response to the instructions of a “netpage pen” (reads on “input assisting actuator associated with the display of the apparatus”) (Silverbrook; column 8, lines 3-22);

further comprising the step of (d) “changing” (reads on “switching” the “[net]page ID” (reads on “screen images on the screen of the display from said primary input screen image to said auxiliary input screen image”) (Silverbrook; Figure 1, column 20, lines 2-5) in response to the instructions of a “netpage pen” (reads on “screen image switch”) associated with the display (Silverbrook; Figure 1, column 20, lines 2-5); and

wherein the common personal data of said first registration data to be input as part of the personal data of the individual remaining customer is a family name of the representative customer if the group is a family (Silverbrook; Figure 63, column 9, lines 34-36).

(D) Claims 26-33 differ from method claims 11, 14, 16, 14, 16, 17, 16, 16 respectively by reciting a “computer readable recording medium which records an automated contract engaging program ...” in the preamble.

As per this limitation, Silverbrook clearly discloses “receiving, in a computer system, data from a sensing device” and “interpreting, in the computer system, said movement of the sensing device as it relates to said at least one parameter” (Silverbrook; column 2, lines 42-59). As such, Silverbrook implicitly includes computer elements such as a computer readable recording medium and a display controller and a contract processor and a contract engaging program. The remainder of claims 26-33 repeat the limitations of claims 11, 14, 16, 14, 16, 17, 16, 16 respectively, and are therefore rejected for the same reasons given above for claims 11, 14, 16, 14, 16, 17, 16, 16.

(E) Claims 34-35 differ from method claims 23, 25 respectively by reciting “[a]n automated contract engaging program for instructing a computer ...” in the preamble.

As per this limitation, Silverbrook clearly discloses “receiving, in a computer system, data from a sensing device” and “interpreting, in the computer system, said movement of the sensing device as it relates to said at least one parameter” (Silverbrook; column 2, lines 42-59). As such, Silverbrook implicitly includes computer elements such as an automated contract engaging program for instructing a computer and a display controller and a contract processor. The remainder of claims 34-35 repeat the limitations of claims 23, 25 respectively, and are therefore rejected for the same reasons given above for claims 23, 25.

(F) Claims 1-8 differ from method claims 11, 14, 16, 14, 16, 17, 16, 16 respectively by reciting “[a]n automated contract engaging apparatus ...” in the preamble.

Apparatus claims 1-8 repeat the subject matter of claims 11, 14, 16, 14, 16, 17, 16, 16 respectively, as a set of elements rather than a series of steps. As the underlying processes of claims 11, 14, 16, 14, 16, 17, 16, 16 have been shown to be obvious in view of the teachings of Silverbrook in the above rejections of claims 11, 14, 16, 14, 16, 17, 16, 16, it is readily apparent that the system disclosed by Silverbrook includes the apparatus to perform these functions. As such, these limitations are rejected of the same reasons given above for method claim 11, 14, 16, 14, 16, 17, 16, 16, and incorporated herein.

(G) Claims 9-10 differ from method claims 23, 25 respectively by reciting “[a]n automated contract engaging apparatus ...” in the preamble.

Apparatus claims 9-10 repeat the subject matter of claims 23, 25 respectively, as a set of elements rather than a series of steps. As the underlying processes of claims 23, 25 have been shown to be obvious in view of the teachings of Silverbrook in the above rejections of claims 23, 25, it is readily apparent that the system disclosed by Silverbrook includes the apparatus to perform these functions. As such, these limitations are rejected of the same reasons given above for method claim 23, 25, and incorporated herein.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied references, Keller et al., U.S. Patent Application Number 2003/0093304, Ohmoto, et al., U.S. Patent Application Number 2001/0021911, Peterson et al., U.S. Patent Number 5, 903, 873, Bosco et al., U.S. Patent Number 5, 191, 522, and Libman, U.S. Patent Number 6, 076, 072 teach the environment of automatically generating contracts.

8. Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks
Washington D.C. 20231**

or faxed to: **(571) 273-8300.**

For informal or draft communications, please label "PROPOSED" or "DRAFT" on the front page of the communication and do NOT sign the communication. After Final communications should be labeled "Box AF."

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

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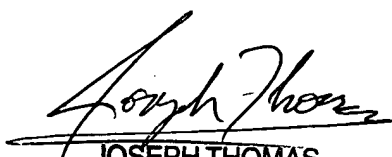
10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Natalie A. Pass

November 29, 2005


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER